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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,636	08/07/2002	Henri Samain	05725.1038	7407
22852	7590	05/10/2004	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			ELHILO, EISA B	
			ART UNIT	PAPER NUMBER
			1751	

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/088,636

Applicant(s)

SAMAIN, HENRI

Examiner

Eisa B Elhilo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 4-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/7/2002.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Claims 1-19 are pending in this application.

### **DETAILED ACTION**

#### ***Claim Objections***

1. Claims 4-16 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and/or, can not depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims have not been further treated on the merits.

#### **Examiner position**

2 The examiner makes of record that instant claims 2 and 3 recite a broad range of components followed by narrow ranges. For examination purposes, the examiner asserts that the narrow ranges recited in the instant claims 2 and 3 are merely exemplary ranges, and thus, the prior art will be applied against the broadest ranges recited in the instant claims 2 and 3. Further, the examiner suggests that applicant should delete the narrow ranges from the instant claims 2 and 3, and add new dependent claims that recite the narrow ranges recited in the instant claims 2 and 3.

#### ***Claim Rejections - 35 USC § 112***

3 The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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4        Claims 17-19 provide for the use of insoluble and deformable organic platelets, but, since the claims do not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 17-19 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Claim Rejections - 35 USC § 103***

5        The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsaor et al. (US 5,441,728) in view of Grollier (US 5,874,091).

Tsaor et al. (US' 728) teaches an aqueous hair composition comprising a latex of water-insoluble polymeric particles in the amount of 1 to 30% by weight of the composition wherein the amount of the polymer falls within the claimed ranges, wherein the particles have an average particle size of 3 micron or less which implies that the particle size may be within the claimed ranges or overlapped with the claimed ranges and wherein the particles have a glass transition

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temperature that lies between 250 K (-23<sup>0</sup>C) and 250 K (26<sup>0</sup>C) as claimed in claim 1 (see col. 4, lines 30-40).

Although Tsaur (US' 728) teaches a hair treating composition that comprises polymeric particles in the claimed amount and having similar size to the claimed size and wherein the particles have a glass transition temperature that falls within the claimed ranges, Tsaur et al. (US' 728), is silent about the thickness of the polymer particles that used in the composition as required by the instant claims.

Grollier (US' 091), in other analogous are of hair treating compositions, teaches a composition comprising polymeric particles having a size in the range of 500 nm and 25,000 nm and a thickness generally greater than 10 nm, which meets the lower limit of the claimed range as claimed in claim 1(see col. 6, lines 7-8).

Therefore, in view of the teaching of the secondary reference, one having ordinary skill in the art would have been motivated to modify the composition of Tsaur (US' 728) by optimizing the thickness of the polymeric particle in the composition as taught by Grollier (US' 091) with a reasonable expectation of success. Such modification would be obvious because the primary reference of Tsaur (US' 728), teaches a composition comprising polymeric particles in the claimed amount with sizes and glass temperatures and the secondary reference of Grollier (US' 091), teaches similar hair treating composition that comprises similar polymeric particles with similar size and thickness, and, thus, a person of an ordinary skill in the art would be motivated to modify the thickness of the polymeric particles in the hair treating composition with a reasonable expectation of success to obtain a highly homogenous composition and would expect such a composition to have similar properties to those claimed. Absent unexpected results.

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Further, the applicant has not shown on record the criticality of the claimed ranges of the thickness of the polymeric particles in the claimed composition.

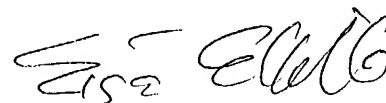
*Conclusion*

The remaining references listed on from 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eisa B Elhilo whose telephone number is (571) 272-1315. The examiner can normally be reached on M - F (8:00 -5:30) with alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eisa Elhilo  
Patent Examiner  
Art Unit 1751

May 6, 2004